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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/703,628	11/10/2003	Tsutomu Sato	ON2-US	2166

7590 04/08/2005

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WASHINGTON, DC 20036

EXAMINER

LEE, SIN J

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/703,628

Applicant(s)

SATO, TSUTOMU

Examiner

Sin J. Lee

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goto et al (US 6,777,156 B1) (with Ando et al (5,912,086) which is cited here to show that "Epoxyester 3000M" is an epoxy acrylate).

In Example 13 (see col.26, lines 55-67, col.27, lines 1-10), Goto teaches a heat sensitive layer composition containing carbon black and novolak resin, and in that example, Goto obtains a *positive type* planographic printing plate.

In col.4, lines 14-19, Goto teaches the equivalence of carbon black and infrared-absorbing dye as his light-to-heat conversion material. Because the prior art teaches the equivalence of those two materials, one of ordinary skill in the art would have found it obvious to substitute the infrared-absorbing dye (*present photo-thermal conversion substance*) for carbon black as Goto's light-to-heat conversion material in his Example 13.

In col.8, lines 64-67, col.9, line 1-23, Goto teaches the equivalence of novolak resin (which is used in his Example 13) and *epoxy-modified phenolic resin* as his compounds containing *phenolic hydroxyl group* (which is to be used as his active hydrogen group-containing compound). Because the prior art teaches the equivalence of those two resins, one of ordinary skill in the art would have found it obvious to substitute the epoxy-modified phenolic resin (*present alkaline soluble organic high molecular substance comprising epoxy resin having phenolic hydroxyl group*) for novolak resin as Goto's compound containing phenolic hydroxyl group in his Example 13.

With respect to present compound that includes any one of (1)-(10), as discussed above, Goto teaches epoxy-modified phenolic resin as one of examples for his phenolic hydroxyl group-containing compounds. Furthermore, Goto teaches (col.9, lines 45-47) that his active hydrogen group-containing compounds can each be used on their own or they can be used in the form of *mixtures of two or more types*. Goto also discloses pyrogallol acetone resin (col.9, lines 18-19) as one of examples for his phenolic hydroxyl group-containing compounds. Therefore, since Goto teaches that

mixtures of two or more types of compounds can be used as his active hydrogen group-containing compounds and since pyrogallol acetone resin is disclosed as one of examples for his phenolic hydroxyl group-containing compounds, it would have been obvious to one of ordinary skill in the art to use the combination of the epoxy-modified phenolic resin and pyrogallol acetone resin (*present ketone resin*) as Goto's active hydrogen group-containing compounds in his Example 13 with a reasonable expectation of obtaining printing plates having high sensitivity and high image reproducibility.

Therefore, Goto's teaching would render obvious present positive-type photosensitive composition of claim 1 (since Goto teaches pyrogallol acetone resin, which is *present ketone resin*, it is the Examiner's position that Goto's pyrogallol acetone resin would inherently have the adherence characteristic reforming properties).

Response to Arguments

4. Applicant argues that Goto et al'156 does not teach or suggest present claim elements (1)-(10). However, as discussed above in Paragraph 3, Goto's teaching renders obvious the use of the mixture of epoxy-modified phenolic resin and pyrogallol acetone resin (*present ketone resin*) as his active hydrogen group-containing compounds in his Example 13. Therefore, Goto's teaching renders obvious present invention of claim 1.

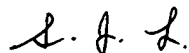
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333.

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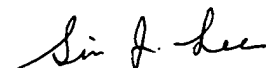
The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee
March 29, 2005



Sin J. Lee
Patent Examiner
Technology Center 1700